

IFW AF/1643

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

IN RE:	Patent Application)	
	Serial No. 09/458,998)	
)	
FILED:	December 10, 1999)	
)	GROUP ART UNIT: 1643
TITLE:	EIA FOR MONITORING)	
	LEGIONELLA PNEUMOPHILA)	
	PRESENCE IN WATER)	
	SAMPLES)	
)	EXAMINER: Ja-Na Hines
)	
APPLICANTS:	Norman James Moore)	
	Myron David Whipkey)	
	James William Welch)	
)	

**RESPONSE TO NOTIFICATION OF
NON-COMPLIANCE WITH 37 C.F.R. 1.192 (c)
MAILED JUNE 10, 2004 AND REQUEST FOR
REINSTATEMENT OF APPEAL**

Applicants' counsel has carefully examined the retained file of the above-identified application.

This file shows that in response to the final rejection of Claims 1-9 mailed August 1, 2001, Applicants filed new claims 10-35, canceled claims 1-9, submitted an argument responding to the final rejection and filed a Request for Continued Examination.

A first rejection of claims 10-35 was mailed January 16, 2002 to which Applicants

responded on July 8, 2002. A *second* rejection of claims 10-35 was mailed October 11, 2002, in response to which Applicants filed an appeal on April 11, 2003:

37 C.F.R. 1.191(a) decrees that

“Every applicant for a patent..., any of whose claims has been *twice or finally* (§1.13) *rejected*, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in §1.17(b) within the time period provided under §§ 1.134 and 1.136 for reply.” (Emphasis added)

Upon consideration of the *second* rejection of claims 10-35 mailed Oct. 11, 2002, Applicants elected to appeal and on April 11, 2003 filed a notice of appeal with check for \$160.00 (the small entity appeal fee then in force) plus a request for 3-month extension of time to respond with check for \$465.00 (the small entity 3-month extension fee at that time).

The notice mailed June 10, 2004 asserts that “there has been no second or final rejection in this patent application” in its first sentence but in its last sentence states that “the instant claims in this patent application have not been finally rejected”. In *fact*, while it is true that claims 10-35, the only claims in the case, have not been *finally* rejected, they *have been twice rejected*--i.e. on January 16, 2002 and again on October 11, 2003. 37 C.F.R. §1.191 (a) clearly leaves it to the Applicants to elect appeal whenever *any* claim has been “*twice or finally*” rejected.

Restoration of this application to appealed status and transmission of the appeal brief to the Board of Patent Appeals and Interferences are hence respectfully requested.

Applicants note that they have *no objection* to the Examiner’s reconsideration of this application or to any other constructive input by the Examiner, including but not limited to the

formulation of an Examiner's Answer to the Appeal Brief, and that this Request for Reinstatement of Appeal is filed *only* to ensure that:

(a) the appeal process overall and the legitimacy of the appeal brief are not in any way clouded by the inapposite "Notification of Non Compliance with 37 C.F.R. §1.192(c)" which has been placed in the file and

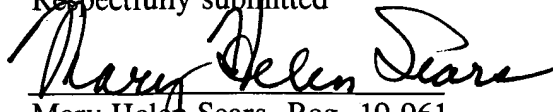
(b) the interjection of this inapposite "Notification of Non-compliance" does not in any way interfere with the progress of the appeal, (assuming that the Examiner does not undertake to withdraw all of the rejections of record upon reconsideration of this application and thereby obviate the appeal.)

Applicants point out that:

1. The appeal was properly filed, in strict compliance with 37 C.F.R. §1.191 (a) as detailed above.
2. While it is perfectly proper, as Applicants understand the rules, for the Examiner to give further consideration to the application at any stage of the appeal process, and Applicants have no objection to that, it is *not proper*, nor countenanced by any rule or statute known to Applicants' counsel to hold an *appeal brief* non-compliant with 37 C.F.R. §1.192(c) because of a postulated, but wholly unsupportable and inaccurately arrived at, lack of compliance with 37 C.F.R. §1.191(a).

Applicants accordingly request withdrawal of the "Notice of Non-Compliance with §37 C.F.R. §1.192 (c)", restoration of the Appeal Brief to compliant status vis-a-vis 37 C.F.R. §1.192 (c) and withdrawal of the inaccurate holding, or *at least* implication, that the appeal was taken prematurely, and hence contrary to 37 C.F.R. 1.191 (a).

Respectfully submitted

A handwritten signature in cursive script, reading "Mary Helen Sears". The signature is written in black ink and is positioned above a horizontal line.

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